

## R E M A R K S

Applicant has carefully considered the Office Action of October 20, 2008, wherein the Examiner has indicated the allowability of claims 97-102, but has objected to claims 82, 83 (not 84 which was previously deleted), 87-91, 95, 111-115, 117, and 123, indicating that they would be allowable if rewritten in independent form. Applicant wishes to express his appreciation to the Examiner for the indication of allowable subject matter.

The present response is intended to fully address all points of objection raised by the Examiner, and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Claim 80 has been amended incorporating the recitation of claims 82-83, consequently, claims 82-83 have been deleted. Claims 98, 106, 117, 124 and 126 have been currently amended to remove the Examiner's rejections. Therefore, claims 80, 85-102, 106-107, 109, 111-115, 117, and 123-127 remain in the case.

The present invention discloses a device and a system for preparing a beverage drink, either hot or cold, utilizing the Peltier principle by selectively introducing and mixing predetermined quantities of a stored beverage preparation confined in a sealed chamber into a portable beverage container. The beverage container contains a predetermined volume of a potable base liquid and has a dispenser means for introducing the beverage preparation into the potable base liquid. The drink container and the sealed chamber are in close proximity to one another and separated by the seal which, when inwardly perforated by the dispenser means, introduces the beverage preparation into the potable base liquid.

The system of the invention further provides a brewing element and a portable heating/cooling unit, the heater element thereof operating on the Peltier principle, such that when inserted into the beverage container and operated, heats/cools the liquid to a predetermined temperature to prepare a ready-mixed drink.

Claims 106, 109, and 124-127 are rejected under 35 U.S.C. Sec. 102(a) as being anticipated by Heczko.

Heczko suggests a beverage preparation system comprising a cartridge within a housing having a hollow interior and a collapsible bag, a compressible bottle containing a liquid, and a cartridge comprising a concentrate within the hollow interior or within the collapsible bag.

Heczko teaches a compressible bottle (claim 21) comprising a combination of a first inner bottle and a second outer bottle interconnected to hold a liquid which differs from the Applicant's "cup unit including an inner cup 42 and an outer cup 12."

Heczko provides a cartridge 104a with a nipple 106 for drinking from, and as typically used in powdered, baby-formula preparations which is not the use or motivation of the Applicant's cup unit. The cartridge 104b in Heczko, alternatively, uses a push-pull top 108 for powdered juice mix or sports drink, but this is different from the Applicant's invention which utilizes preformed orifices such as a lip for drinking.

Furthermore, Heczko's invention differs both functionally and structurally from the Applicant's invention. Heczko requires a user to insert a cartridge within the water-filled bottle, to invert the bottle to initiate displacement of the water, to squeeze the bottle, and to shake it. The Applicant's invention already contains a capsule brewing element. In Heczko, the operation is a manual one requiring squeezing and relaxing pressure on the bottle, whereas in the Applicant's invention, this is accomplished mechanically and cyclically by a pump unit within an attachable heating/cooling unit.

The Applicant respectfully traverses the opinion of the Examiner stating that a threaded connection on inner and outer bottles in Heczko may be considered "integral." The Examiner uses this to support his holding of obviousness in relation to the Applicant's invention which comprises an inner and outer cup which are integrally formed. The definition of "integral" does not mean

simply an essential part of a whole, but rather refers to an inseparable part of a whole, much as a limb of a human is an integral part of the body. Thus the threaded connection in Heczko provides no basis for the anticipation of the Applicant's invention which does not require a threaded connection.

Method claims 124 and 126 have been amended to now recite the relationship between the structural limitations and the method.

As stated in the decision in *In Re Marshall*, 198 USPQ 344 (1978), "To constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art...". Since the Heczko reference neither 1) identically describes the invention, nor 2) enables one skilled in the art to practice it, Applicant deems the Sec. 102(a) rejection improper, and respectfully requests that it be withdrawn.

Claim 107 is rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over Heczko in view of Chang. Claims 80, 81, 85, 86, 92-94, and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Oakley and Lee *et al.* The Examiner has rejected Applicant's arguments (submitted in the August 12, 2008 response) with regard to claims 80, 83, 85, 86, 92-94 and 96 as being moot in view of the new grounds of rejection.

Chang (US Pat. 6,172,340) teaches "a plurality of protective strips" that act "as a heat isolation barrier." In contrast, the present invention utilizes ribbing which protrudes from the cup and act not only as a heat barrier, but actually are formed to disperse excess heat into the air to enable comfortable handling of a hot cup filled with, for example, an espresso drink.

Oakley *et al.* (US Pat. 4,738,378) introduces water into a sachet from a reservoir to mix with the contents of the sachet which is thereafter discarded. This is unlike the environmentally friendly cup in the Applicant's invention which retains the used brewing element and is disposable together with the cup. The sachet in Oakley is an add-on and not built into a cup and therefore requires separate disposal, which is messy.

Furthermore, the system in Oakley is not a portable "beverage dispensing apparatus", but loaded into "an open door of the machine" rather than being built into the system of a portable self-contained cup unit as in the Applicant's invention.

Klein (US Pat. 4,452,130) discloses an apparatus for preparing a hot beverage, but does not disclose withdrawal of a potable liquid from the portable beverage container for heating/cooling.

Lee (US Pat. 5,771,788) discloses a food storage device employing a thermoelectric element based on the Peltier effect. There is no disclosure of a beverage preparation device or withdrawal of a potable liquid from the portable beverage container for heating/cooling.

Therefore, the patents to Chang, Oakley, Klein and Lee add nothing to the teaching of Heczko which would render the present invention obvious.

Moreover, it is the Applicant's position that the combination of Heczko and Chang, Oakley, Klein or Lee to form the basis of the Sec. 103(a) rejection is improper, and Applicant respectfully requests that it be withdrawn.

Claims 82-83 are deleted. Claims 81, 84, 103-105, 108, 110, 116, and 118-122 were previously deleted. Claims 80 and 106 are currently amended. Therefore, independent claims 80 and 106 are deemed to be patentable, and the dependent claims as previously presented are deemed to be patentable as being based thereon and not obvious. Independent claims 124 and 126 (currently amended) and the dependent claims are also deemed to be patentable.

In citing the references under Sec. 103(a), the question is raised whether the references would suggest the invention, as stated in the decision of *In Re Lintner* (172 USPQ 560, 562, CCPA 1972);

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification."

Similarly, In Re Regel (188 USPQ 136, CCPA 1975) decided that the question raised under Sec. 103 is whether the prior art taken as a whole would suggest the claimed invention to one of ordinary skill in the art. Accordingly, even if all the elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

Simply put, and as stated in In Re Clinton (188 USPQ 365 CCPA 1976), "do the references themselves... suggest doing what appellants have done", such that there is a requirement that the prior art must have made any proposed modification or changes in the prior art obvious to do, rather than obvious to try.

As stated in Application of Wesslau, 353 F.2d 238, 241 (CCPA 1965):

"It is impermissible within the framework of Sec. 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggest to one of ordinary skill in the art."

The Examiner is relying on speculation and hindsight reconstruction of the references in view of the invention.

As stated in Grain Processing Corp. v. American Maize-Products Corp., 840 F.2d 902, 908 (Fed. Cir. 1988):

"Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit."

As stated in Re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1998), before prior art references can be combined or modified, there must be some suggestion or motivation found in the art to make the combination or modification.

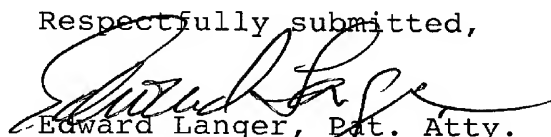
The only motivation for the modification suggested by the Examiner is provided by the Applicant's invention. The Applicant is

the first to recognize the need for a system for preparing a beverage drink, by selectively introducing and mixing predetermined quantities of a stored beverage preparation, confined in at least one sealed chamber having a seal, into a portable beverage container containing a predetermined volume of a potable base liquid.

It is respectfully put forward by the Applicant that there is no reason to consider the prior art references, Heczko, Chang, Oakley, Klein or Lee, et al., either individually or in combination, as rendering the invention obvious.

In view of the foregoing remarks, all of the claims in the application as currently amended are deemed to be allowable. Further reconsideration and allowance of the application is respectfully requested at an early date.

Respectfully submitted,



Edward Langer, Pat. Atty.  
Attorney for Applicant  
Reg. No. 30, 564

5196546/2

Shiboleth, Yisraeli, Roberts, Zisman & Co  
1 Penn Plaza, Suite 2527, New York, NY 10119  
Tel: (212) 244-4111 Fax: (212) 563-7108